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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/628,519 | 07/28/2003 | Gregory A. Ehlers | 68,180-004 | 4286 |
| 26753 | 7590 | 11/21/2007 | | |
| ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202 | | | EXAMINER SHERR, CRISTINA O | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 11/21/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/628,519 | EHLERS ET AL. | |
| | Examiner | Art Unit | |
| | Cristina Owen Sherr | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/8/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-38 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) 7-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,37,38 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's amendment filed August 8, 2007. Claims 1, 3, 6, 37, 38, and 42 have been amended. Claim 2 has been canceled. Claims 1, 3-38 and 42-47 are currently pending in this case. Claims 1, 3-6, 37-38 and 42-47 are currently under examination in this case.

Response to Arguments

2. Applicant's arguments filed August 8, 2007 have been fully considered but they are not persuasive.

3. Applicants argue, with respect to claims 1 and 42, as currently amended, that nothing in the cited prior art teaches, suggests, or discloses allowing "the utility to manage the consumption of a commodity based upon activation of the energy management program".

4. Examiner respectfully disagrees and directs attention to Ehlers, wherein "The utility company can access selected utilization data and control at least some loads via messages to the first microcomputer." (abstract) Further, "The utility company can also access selected utilization data and can also control at least some of the customer's loads via messages to the first microcomputer when the customer subscribes to or authorizes the utility company to perform such services. " (col 5 ln 50-55).

5. Applicants argue, with respect to claims 1 and 42, as currently amended, that nothing in the cited reference teaches, discloses or suggests "the step of measuring the instantaneous rate at which the commodity is being delivered to each device of the subset and sending the instantaneous rate for each device to the utility in real time."

6. Examiner respectfully disagrees and directs attention to Ehlers, wherein "By using the system to provide remote monitoring and load-shedding commands, a utility company can deliver energy to a customer on a pre-paid basis (see below). When the utility company detects that the customer has exceeded the pre-payment or has exhausted its credit, service to the customer can be remotely disconnected (or later reconnected)." (col 29 ln 8-14). Further, "The first microcomputer 18 also can communicate with the power company via a suitable communications interface 16 and associated channel to receive real-time energy rate broadcasts, load shedding requests and the like, and to send to the utility company power outage reports, low voltage condition reports, customer usage reports and selected other data." (col 15 ln 5-11) Clearly "and the like" includes such data as energy delivery.

7. Applicants argue, with respect to claims 1 and 42, as currently amended, that nothing in the cited reference discloses, teaches or suggests "the utility determining a capacity that may be managed by activating the energy management program."

8. Examiner respectfully disagrees and directs attention to Ehlers, at figure 20, wherein KVAH (normally Kilo Volts per Ampere/hour, and thus a measure of capacity) is among the various parameters taken into account by the utility.

9. Applicants argue, regarding claims 1 and 42, as currently amended, that nothing in the cited reference teaches, discloses or suggests "at least one of a rate and a change in the rate at which the commodity is being delivered to the subset of devices following the activation of the program."

10. Examiner respectfully disagrees and directs attention to Ehlers, wherein "The first microcomputer 18 also can communicate with the power company via a suitable communications interface 16 and associated channel to receive real-time energy rate broadcasts, load shedding requests and the like, and to send to the utility company power outage reports, low voltage condition reports, customer usage reports and selected other data." (col 15 ln 5-11).

11. Applicants argue, regarding claim 37, as currently amended, that the cited reference does not teach, disclose or suggest "determining the reduction in the amount of commodity being consumed and verifying the management of the devices within the subset of the devices based upon the actual consumption of the commodity by each of the devices following activation of the energy management program".

12. Examiner respectfully disagrees and directs attention Ehlers, wherein figure 16B shows determining commodity usage at different times for the purpose of comparison.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 3-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehlers et al (US 5,572,438).

15. Regarding claim 1 –

Ehlers discloses a method for providing at least one program to a utility of a commodity, the program aimed at managing demand for the commodity, the utility delivering the commodity to at least one customer site, the customer site having a plurality of devices which use the commodity, including the steps of:

defining a program at the utility having a subset of the plurality of devices for which usage of the commodity may be managed by activating the program (e.g. col 9 ln 9-10, 50-55);

delivering the commodity to the subset of devices (col 3 ln 55-65);

measuring the instantaneous rate at which the commodity is being delivered to each device of the subset of devices (col 15 ln 5-10);

sending the instantaneous rate for each device within the subset to the utility (col 15 ln 15-10); and

determining at the utility, in real time, a capacity associated with the delivery of the commodity to the subset of devices that may be available for management by activating the program (e.g. col 14 ln 60-col 15 ln 15);

activating the program (e.g. col 32 ln 57- col 33 ln 5); and,

subsequently measuring at least one of a rate and a change in the rate at which the commodity is being delivered to the subset of the devices (e.g. col 15 ln 5-10).

16. Regarding claim 3 –

Ehlers discloses a method, as set forth in claim 2, including the step of determining an actual capacity of the commodity saved by activating of the program (e.g. col 14 ln 60 – col 15 ln 50).

17. Regarding claim 4 –

Ehlers discloses a method, as set forth in claim 3, including the step of providing at least one of an alternate rate and a billing adjustment rebate to at least one customer as a function of the actual capacity managed at the related customer site by the program (e.g. col 12 ln 3-20).

18. Regarding claim 6 –

Ehlers discloses a method, as set forth in claim 2, including the step of verifying management of the devices within the subset of the devices (e.g. col 12 ln 2-60).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers et al (US 5,572,438).

21. Regarding claim 5 –

Ehlers does not specifically disclose a method, as set forth in claim 4, wherein the at least one of an alternative rate and a billing adjustment is also a function of historical usage information. However, Ehlers does disclose both variable rater billing (e.g. col 28 ln 63-65) and historical usage or consumption monitoring (e.g. col 27 ln 5-40). It would be obvious to one of ordinary skill in the art at the time the invention was made to put

these together and make historical consumption a factor in determining variable rate billing.

22. Claims 37-38 and 42-47 are rejected under the same criteria as above.

23. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

24. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

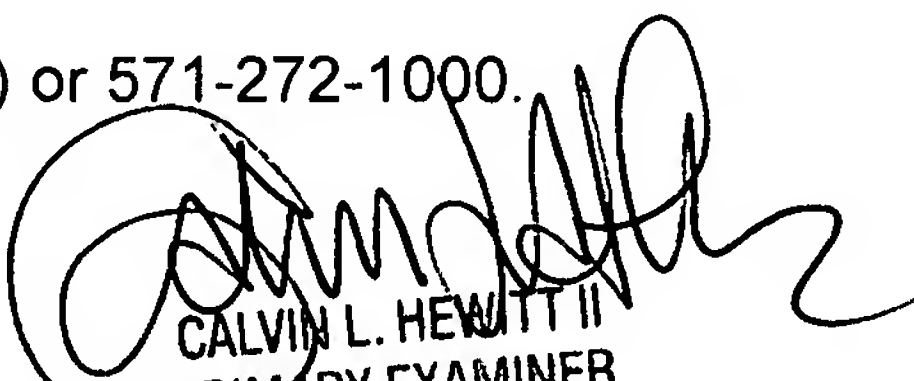
25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cristina Owen Sherr
Patent Examiner, Au 3621


CALVIN L. HEWITT II
PRIMARY EXAMINER